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Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARLO ORLANDO

Appeal No. 2003-1887
Application No. 09/780,914

ON BRIEF

Before OWENS, TIMM and PAWLIKOWSKI, Administrative Patent Judges.
PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-12 and 14-22. Claims 1 and 11 are representative of the subject matter on appeal and are set forth below:

1. A method for preparing a soy-based pasta comprising:
 - (a) combining soy flour, farina, gluten, and a fluid ingredient into a dough, wherein the weight percentage of soy flour out of the four said ingredients is at least 50%; and
 - (b) forming said dough into a desired shape.

11. A soy-based pasta having a dough comprising:

(a) a combination of soy flour, farina, gluten, and a fluid ingredient, wherein the weight percentage of soy flour out of the four said ingredients is at least 50%;

wherein the dough is formed into a desired shape.

The examiner relies upon the following references as evidence of unpatentability:

Hsu	4,675,199	June 23, 1987
Sammet (GB)	1 541 797	Mar. 7, 1979

Claims 1, 3-12 and 14-22 stand rejected under 35 U.S.C. § 103(b) as being unpatentable over Sammet in view of Hsu.

On page 2 of the brief, appellant groups the claims according to process claim 1 and product claim 11. We consider each of these claims. 37 CFR § 1.192(c)(7) and (8)(2000).

In this appeal, we use the substitute Brief filed on November 29, 2002.

OPINION

For the reasons set forth in the Answer and below, we affirm the rejection.

Beginning on page 4 of the Answer, the examiner states that Sammet discloses a process comprising the steps of combining soy flour, farina, eggs, and water to form a dough and forming the dough into pasta articles. The examiner finds that the amount of soy product used in Sammet may be from 6-65% by weight. The examiner states that Sammet does not utilize gluten as an ingredient in making the pasta. However, the examiner relies on

Hsu for teaching that it is well known, in the art of pasta-making, to use gluten as a pasta ingredient as a protein material.

We agree with the examiner that Sammet teaches combining soy flour, farina and a fluid ingredient as claimed by appellants, and we also agree that Hsu teaches that gluten is a well-known pasta ingredient.

We observe that throughout appellant's Brief, appellant argues that Hsu lacks required teachings. We note, however, that one cannot show nonobviousness by attacking the references individually where the rejection is based on the combined teachings of the references. As explained by the Court in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981):

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

As pointed out by the examiner on page 6 of the Answer, Hsu was relied upon only for teaching that gluten is a commonly used protein material in pasta products. The examiner states that Sammet was relied upon for teaching a method for preparing soy based pasta comprising combining soy flour, farina, and a fluid ingredient into a dough and then forming the dough into a desired shape. These combined teachings are used by the examiner in rejecting the claims. Hence, we are unconvinced by appellant's allegations that Hsu does not teach the claimed subject matter because Sammet is primarily relied upon by the examiner.

With specific regard to Sammet, appellant argues that Sammet discloses soy grits and not flour. Brief, page 4. We disagree. Sammet discusses soy flour, beginning in column 1 at line 16. In a preferred embodiment, Sammet indicates that it has been found that the consistency and baking qualities of pasta are improved when a proportion of soya is in the form of grits rather than flour. We note that a preferred embodiment is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered. In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); In re Mills, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972). Therefore, we disagree with appellants' characterization that Sammet does not disclose soy flour.

With regard to appellant's comments that his pasta has a surprisingly pleasing taste, we refer to the examiner's response beginning on page 7 of the Answer and incorporate that response as our own. For the reasons set forth by the examiner on page 7 of the Answer, we determine that appellant's rebuttal evidence regarding the surprisingly pleasing taste of their pasta is insufficient to overcome the obviousness rejection.

In view of the above, we therefore affirm the rejection.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Terry J. Owens)	
Administrative Patent Judge)	
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Catherine Timm)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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